

BARNES & THORNBURG LLP

600 One Summit Square
Fort Wayne, Indiana 46802
(260) 423-9440

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Customer No.: 23641

Application No.: 10/630875

Confirmation

No.: 7941

Filing Date: July 30, 2003

Group Art

Unit: 1794

Examiner

Name: Jennifer A. Chriss

Attorney

Docket No.: 29595/82608

First Named

Inventor: Garry E. Balthes

Title: LAMINATED COMPOSITION FOR
A HEADLINER AND OTHER
APPLICATIONS

Sir:

I hereby certify that this correspondence
is being electronically filed with the
Commissioner for Patents

on: December 28, 2007

/GSC/

Gregory S. Cooper

This reply brief responds to the Examiner's answer filed October 30, 2007. Appellants are requesting an oral hearing of this appeal concurrently herewith.

Argument

- A. The Examiner improperly dismisses evidence from the specification and from one of ordinary skill in the art to conclude Webster's dictionary definition applies.¹**

¹ References to the Examiner's Answer are identified as "Ex. Ans. at ____."

The Examiner maintains the proper definition of “headliner” is a “fabric covering the inside roof of an automobile” pursuant the Webster’s Ninth New Collegiate Dictionary because the specification purportedly does not explicitly define it. (*See Ex. Ans. at 7*). The Examiner erroneously concludes that without an explicit definition the flexible convertible top of Jarrard *et al.* reads on the claimed headliner according to MPEP § 2111.01. (*Id.*)

During prosecution of a patent application, the scope of the claims is not determined solely on the basis of the claim language, but upon giving the claims their broadest reasonable construction in light of the *specification* as it would be *interpreted by one of ordinary skill in the art*. *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004)(emphasis added); *see also Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (The scope of the claimed invention is determined by giving the claims the "broadest reasonable interpretation consistent with the specification."). Nowhere does it say determined based on a dictionary definition despite the specification or one skilled in the art.

Nothing in the Examiner’s argument demonstrates Webster’s definition is consistent with the specification, let alone the understanding by one skilled in the art. Nowhere in the specification is a headliner defined as a fabric or is even consistent with a fabric. In fact, the background of the specification says:

vehicle headliners have sufficient impact absorption and sound absorption, as well as the ability to receive any variety of aesthetically pleasing coverings.

(Paper 7-30-03 at 2-3). Webster’s definition is consistent with what the specification calls the *covering for the headliner*, not the headliner itself. Indeed, Claim 19 at issue is not directed to an aesthetically pleasing covering for use on a headliner, but rather the actual “headliner” panel.

The Examiner offers absolutely no evidence that a “fabric” is the quintessential structure that defines a headliner, or is consistent with the specification or understanding by one skilled in the art.

On the other hand, in addition to the specification, the Appellants have filed evidence that includes pictures of a headliner along with a contrasting flexible convertible top, an actual piece of a headliner to evaluate, headliner testing criteria not only from Toyota but from Johnson Controls (not limited to the year 2006), and a declaration from one of the inventors, all identifying a headliner as a rigid panel. The Examiner is wholly silent on all this evidence except for a brief comment on the Toyota headliner criteria. There is no contrary evidence in the record demonstrating that one skilled in the art would interpret the claimed “headliner” as anything other than a rigid panel.

Indeed, the sum of the Examiner’s discussion of the 2006 Toyota headliner criteria is that the data is only for 2006 and, thus, not persuasive. (*See* Ex. Ans. at 9). The Examiner is obligated however, if she disagrees, to challenge the evidence with contrary evidence. *See* 37 C.F.R. § 104(c)(2). Here the Examiner fails to cite evidence why the headliner criteria includes flexible convertible tops for other years. More importantly, the Examiner ignores the other evidence including the Johnson Controls’ headliner qualifications drafted prior to 2006, or the actual piece of headliner itself. Pictures of the vehicle headliner include an explanation of how a headliner is different to one skilled in the art than a flexible convertible top. (*See* Paper 08-31-2006 at ¶ 8). The inventor’s statement that “those skilled in the art know a headliner is a strong, rigid body molded in a 3-dimensional shape” is also not challenged by the Examiner. (*See* *id.* at ¶ 5). In light of this undisputed evidence, the only conclusion that can be drawn is that a “headliner” is an inherently rigid body or panel and not the same thing as a flexible soft-cover

convertible top.

The Examiner argues MPEP § 2111.01, Heading III, provides authority for using Webster's definition in the absence of an explicit definition in the specification. (See Ex. Ans. at 10). This is respectfully believed inaccurate, not only in light of *Am. Acad.* and *Phillips*, as previously discussed, but also because MPEP § 2111.01 offers no such authority. An inescapable theme from Heading III is that in the absence of any expressed intent, a term is presumed to take on the ordinary and customary *meaning by one of ordinary skill in the art*. Moreover, *Phillips* specifically rejects the Examiner's use of the dictionary where no explicit definition appears in the specification. See 415 F.3d at 1320-21.² In fact, *Phillips* specifically warns against the Examiner's application of the dictionary by stating:

[t]he main problem with elevating the dictionary to such prominence is that it focuses the inquiry on the abstract meaning of words, rather than on the meaning of claim terms within the context of the patent. Properly viewed, the "ordinary meaning" of a claim term is its meaning to the ordinary artisan after reading the entire patent. Yet heavy reliance on the dictionary divorced from the intrinsic evidence risks transforming the meaning of the claim term to the artisan into the meaning of the term in the abstract, out of its particular context, which is the specification.

(*Phillips* 415 F.3d at 1321). Nowhere does the law allow a dictionary definition to supplant evidence from the specification as understood by those skilled in the art. And nowhere in the specification is a headliner defined as a piece of fabric usable as a flexible convertible top.

² Assigning such a limited role to the specification, and in particular requiring that any definition of claim language in the specification be express, is inconsistent with the ruling that the specification is "the single best guide to the meaning of a disputed term," and that the specification "acts as a dictionary when it expressly defines terms used in the claims or when it expressly defines terms used in the claims or when it defines terms by implication." *Vitronics*, 90 F.3d at 1582; *Irdeto Access, Inc. v. Echostar Satellite Corp.*, 383 F.3d 1295, 1300 (Fed. Cir. 2004) ("Even when guidance is not provided in explicit definitional format, the specification may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents.") (citations omitted); *Novartis Pharms. Corp. v. Abbott Labs.*, 375 F.3d 1328, 1334-35 (Fed. Cir. 2004); *Bell Atl. Network Servs., Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 1268 (Fed. Cir. 2001) ("[A] claim term may be clearly redefined without an explicit statement of redefinition.").

In this case, the purpose of the claimed headliner is to be dimensionally stable in high temperature environments and have reduced sag (i.e., not bend) in the range of millimeters by using stiffening materials that make the headliner rigid. (*See* paper 7-30-03 at 2-3, 7, and 11). And even though the specification contemplates headliner applications that might allow deflection greater than 1 centimeter, this is certainly not a disclaimer that the headliner is the same thing as the flexible convertible top of Jarrard *et al.*, which is required to be sufficiently bendable to an angle of at least 45° under minimal effort. (*See id.* at 11 and contrast with U.S. Patent No. 6,871,898 at col. 2, lns 6-12).

The other evidence discussed in Appellants' brief, such as the class/subclass distinctions, sisal being a rigid material, and the Examiner's prior descriptions of prior art, are relevant to demonstrate that headliners are known to be different structures from convertible tops and the Webster's definition is out of place and context in this art. Indeed, the different subclasses for headliners and convertible tops simply demonstrate that the Patent Office recognizes they are different structures. (*See* Ex. Ans. at 8). The Examiner's conclusion that Jarrard *et al.* could be classified in subclass 214 is only speculation. The Examiner's conclusion that sisal is a "stiff filler material" supports Appellants' arguments. (*Id.* at 8-9). And the Examiner's argument that descriptions of the prior art as "stiff" and "rigid" were merely "describing the prior art used in the rejections" fails to acknowledge that art was cited because they were "stiff" and "rigid" structures. Only now that the alleged anticipatory reference is "flexible" are the characteristics "stiff" and "rigid" no longer relevant.

B. Jarrard *et al.* nevertheless fails to teach each and every limitation of Claim 19.

The Examiner still equates the claimed "headliner core layer" with Jarrard's foam layer. (*Ex. Ans.* at 10). What is omitted from the Examiner's analysis, however, is that Jarrard *et al.*

does not simply teach a “foam layer,” but rather a “flexible foam layer.” (See U.S. Patent No. 6,871,898 at Abstract, and cols. 1, 2, 4, 6, 11, 12). The flexible soft cover of Jarrard *et al.* is also used as an awning or tent. (See *id.* at col. 9, lns. 6-46). This is why the Examiner must construe the headliner as a “fabric” and not a rigid structure contrary to the evidence. It is obviously difficult to argue a fabric by itself is not flexible, and it is well established that an inherency rejection may not be based on probabilities or possibilities, or the mere fact that a certain thing may result from a given set of circumstances. See *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) (citations omitted). The only way to attempt to equate the “flexible foam layer” to the “headliner core layer” is to construe the “headliner” as a flexible fabric. As undisputed evidence demonstrates above, however, the rigidity component of the headliner is essential and cannot be ignored.

Setting aside rigidity for the moment, Jarrard *et al.* still does not disclose each claim limitation of Claim 19. For example, the Examiner maintains Jarrard *et al.* teaches the fibers being incorporated into the flexible foam layer and equating that with the claimed headliner core layer comprising a binding resin and randomly-oriented natural fibers dispersed throughout the core layer’s thickness. On its face, prior art describing the fibers being able to be either laminated on top of or incorporated into foam is not the same as the fibers being disbursed throughout the entire thickness with resin.³ For the flexible foam layer to inherently anticipate the headliner core layer, it must possess the same characteristics of the claimed product. See *id.* The headliner core layer is part of a rigid headliner of the type demonstrated by the evidence previously discussed. Fibers simply laminated on top of or incorporated into flexible foam

³ This is in addition to the fact that the Examiner does not evidence how simply “incorporating” is the same as “dispersed throughout the layer’s thickness.”

inherently produce something different than a headliner core layer with randomly-oriented natural fibers dispersed throughout the layer's thickness. Producing different structures means they are not equal and, thus, cannot be equated.⁴

With respect to the film layer, it appears the Examiner and Appellants agree that the film layer should be construed as "an extremely thin continuous sheet of a substance that may or may not be in contact with the substrate." (Ex. Ans. at 11). The Examiner simply argues that Jarrard *et al.* is a different prior art reference than the one discussed in the 2-28-05 affidavit, and cites col. 6, lns. 1-10 of Jarrard *et al.* for the proposition that a stain resistant coating teaches a film layer.⁵ The Examiner does not address how the treated fibers from U.S. Patent No. 5,895,301 at col. 3, lns. 18-19 and the fabric treatment from U.S. Patent No. 6,871,898 are substantively different. They are both merely treating fibers, not producing a film layer. The Examiner concludes this point with respect to one flexible panel, but not the other. The Appellants argue that both prior art references teach a surface treatment of the fibers. The uncontested Affidavit asserts that, "[i]ndividual fibers being treated with a resin is not a composite layer applied to the surface of a second layer." (Paper 2-28-05 at 3, section 5). The fact the references are different is of no consequence if they both disclose a substantially similar surface treatment of fibers.

C. Jarrard *et al.* teaches away from the invention of Claims 20, 42 making its combination with Spengler inappropriate.

The Examiner maintaining that both Jarrard and Spengler are directed to roof panels and Jarrard *et al.*, albeit a flexible panel, still requires strength and is not specific to any type of fiber. The Examiner further alleges Spengler provides motivation to choose sisal because of "desired

⁴ The examiner also does not evidence how "flexible foam" is the same thing as "resin."

characteristics of the panel and based on availability and cost as it is suitable material for use in a roof panel.” (Ex. Ans. at 12).

With respect to Claim 20, the Examiner’s answer does not argue against any of the Appellants’ positions in the Appeal Brief. It can, therefore, be inferred the Examiner concedes those arguments. Nonetheless, even if assumed that the Examiner maintains the original obviousness rejection as reprinted on page 6 of the Examiner’s Answer, it is still respectfully submitted that the rejection is not supported.

As required under *KSR International Co. v. Teleflex, Inc.*, the *Graham* factors are the controlling inquiries in the obviousness analysis. See 550 U.S. at _____. The first step in this inquiry is determining the scope and content of the prior art, which includes construing each limitation consistent with the specification as understood by one skilled in the art (not in a vacuum using a dictionary definition). See *Phillips*, 415 F.3d 1303, 1316 (Fed. Cir. 2005); see also MPEP § 2111. For the reasons discussed above, Jarrard *et al.* is not directed to a headliner, nor includes a headliner core layer.

The second *Graham* factor – ascertaining the differences between the claimed invention and the prior art – requires the prior art to at least read on each limitation of the claim. Again, for the reasons discussed above, Jarrard *et al.* does not disclose every limitation of the headliner in base Claim 19. Nevertheless, the Examiner’s analysis on page 7 alleges Jarrard *et al.* teaches use of cotton to structurally reinforce a “resin” layer. The problem is that Jarrard *et al.* describes incorporating or laminating cotton, not both. In this case the laminate layers do not coincide with

⁵ The reference to “protective bottom layer” and “film used” from lines 2 and 4, respectively in the portion of column 6 cited by the Examiner, is not referring to the film layer in dispute, but rather the claimed woven layer from

the claimed invention, even if the cotton is replaced with sisal per Spengler. Also, the cotton (or natural fiber) is “incorporated,” into “foam” not “resin.” None of this is describing the use of a polypropylene resin in the headliner core layer. In fact, example 2 of Jarrard *et al.* describes using a “100% cotton square woven scrap layer below a PVC skin coat layer.”⁶ (See col. 10, lns. 37-45).

With respect to Claim 42, it only requires the randomly-oriented natural fibers in the headliner core layer be sisal. By merely concluding sisal can be used for “strength” citing a general statement from Spengler that the natural fiber choice is merely a cost issue, does not, of course, rectify the deficiencies between Jarrard *et al.* and Claim 19. (See Ex. Ans. at 12). The argument, however, serves to contradict the Examiner’s own arguments. In particular, both the Examiner and the Appellants agree that sisal is a “stiff filler material.” (Ex. Ans. at 9). Jarrard *et al.* requires the composite be “sufficiently flexible to be bendable to an angle of 45° preferably at a force less than 300 grams per centimeter, more preferably at a force of about 100 to about 240 grams per centimeter, and most preferably at a force of about 150 to about 200 grams per centimeter as measured by the cantilever bending test (ASTMD 5732).” (U.S. Patent No. 6,871,898, col. 2, lns. 6-11). Clearly this requirement teaches away from using a stiffening material, either incorporated into or as another layer.

For these reasons, the Appellants respectfully assert the rejections cannot be sustained.

claim 19. The claimed “film layer” is equated to the stain resistant treatment only. (See Ex. Ans. at 3).

⁶ The Examiner fails to rebut the argument from Appellants’ brief at 12-13 that the two references teach away from each other.

To the extent additional fees are required, please charge the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 02-1010 (29595/82608) and please credit any excess fees to such deposit account.

Respectfully submitted,

/GSC/
Gregory S. Cooper
Reg. No. 40,965
(260) 425-4660